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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,537	09/07/2001	Thomas Heering	T.HEERING	9176

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JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

EXAMINER

LIVERSEDGE, JENNIFER L

ART UNIT	PAPER NUMBER
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3692

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/856,537	Applicant(s) HEERING, THOMAS	
	Examiner Jennifer Liversedge	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 6-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/856,537 filed January 5, 2007. The amendment contains the following:

The amendment contains amended claims: 6-7.

The amendment contains previously presented claims: 1, 3 and 8-10.

Claims 2 and 4-5 were previously canceled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term "the final number" is part d is not clear. The description in the specification does not disclose the meaning of "the final number".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1, 3 and 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitations "...the build up..." in part b; "...the requested service..." in part c; and "...the final number..." in part d. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 6 and 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by EP 0 765 068 A2 to Yzhak Ronen (further referred to as Ronen).

Regarding claim 1, Ronen discloses a method of billing a fee for a service via an electronic route (column 1, line 55 – column 2, line 19; column 4, lines 50-59), comprising the steps of:

a) transmitting a telephone number of a chargeable service telecommunication connection associated with a service provider to a service buyer (column 5, line 58 – column 6, line 4; column 9, lines 1-7; column 10, lines 3-10);

b) monitoring the build-up of the telecommunication connection between the provider and the buyer by a line provider (column 6, lines 9-38);

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c) billing the fee for the requested service via the service connection (column 5, line 58 – column 6, line 19; column 7, lines 18-51; column 9, lines 12-16); and

d) releasing the requested service to the buyer by the service provider, whereby an order code is allocated and transmitted to the service buyer during transmission of the telephone service number by the service provider, and wherein the service connection is a direct-dial connection of which the final number is used as the order code (column 1, line 55 – column 2, line 19; column 2, lines 34-53).

Regarding claim 3, Ronan discloses the method wherein the requested service is billed after the order code has been confirmed by the service buyer (column 2, lines 34-53; column 3, lines 18-34; column 9, lines 1-7; column 10, lines 8-17).

Regarding claim 6, Ronan discloses the method wherein the service connection is disconnected by the service provider following the complete billing of the fee for the requested service (column 6, lines 20-30).

Regarding claim 8, Ronan discloses the method wherein billing is carried out continuously in parallel with transmission of the service (column 6, lines 9-25; column 9, lines 11-16).

Regarding claim 9, Ronan discloses the method wherein the line to the service connection is built up automatically on the side of the buyer (column 2, lines 5-19 and

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lines 34-53; column 5, line 58 – column 6, line 19; column 7, lines 18-21; column 9, lines 1-15; column 10, lines 3-17).

Regarding claim 10, Ronan discloses the method wherein the requested service is built up via the Internet (column 1, line 55 - column 2, line 19; column 4, lines 50-59; column 5, line 58 – column 6, line 29; column 7, lines 18-56; column 9, lines 1-15; column 10, lines 3-37).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ronan.

Ronan does not specifically disclose the method wherein billing is terminated if the service line is disconnected before complete billing of the fee for the requested service.

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However, Ronan discloses billing for services provided by an ISP to a user by way of a telephone number for affecting those charges (column 1, line 55 – column 2, line 19; column 5, line 58 – column 6, line 4). It would be obvious to one of ordinary skill in the art that if the service were to be interrupted such that that service was not provided, then the billing would accordingly be terminated. Ronan discloses billing for services. If no service is provided, then it would be inappropriate to charge the user for a service they did not receive.

Response to Arguments

Applicant argues that Ronen fails to disclose using “the final number” of the service connection as an order code. As stated above, the reference to “the final number” is rejected under 112 as this is not explained or referenced in the specification. Based on a reading of the specification, however, Ronen discloses the mechanisms for the use of telephone numbers and order codes as disclosed in the present application.

For example, on page 3, line 31 – page 4, line 2 of the current specification, Applicant discloses a specific order code being transmitted simultaneously with the transmission of the service telephone number by the service provider and where the customer calls the service telephone number and enters the code. Ronen discloses a specific order code being transmitted simultaneously with the transmission of the service telephone number by the service provider and where the customer calls the service telephone number and enters the code in each of columns 2, 3, 8, 9 and 10.

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By means of another example, on page 4, lines 4-8 of the current specification, Applicant discloses where a phone number serves as the code. Ronen discloses where a phone number serves as the code, for example in column 2, where the telephone number is recognized for association when the user directly contacts the ISP, or in another embodiment where the user can access over the Internet through entering the ISP phone number and an identification number supplied by the ISP.

Further, in column 9, Ronen discloses where the telephone number provided by the user must match the Automatic Number Identification (ANI) provided to the ISP, such that the phone number is the pass code to proceed.

In each case, a phone number is entered and/or recognized depending on the embodiment. The user must enter the corresponding provided phone number in order for a match to be made such that the number is a critical element is associating the user with the service and corresponding means of billing.

Regarding the rejection of claim 7 made under 103(a) and Applicant's argument that a prima facie case of obviousness was improperly made, the Courts have stated that "**[a] suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art**, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references...The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art... there must be some articulated reasoning with some rational underpinning to

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support the legal conclusion of obviousness." (emphasis added) In re Kahn, 78 USPQ2d 1329, 1336 (CA FC 2006). Examiner asserts that such "articulated reasoning" to support the legal conclusion of obviousness has been provided.

Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at 571-272-6777. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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RICHARD E. CHILCOT, JR.
SUPERVISORY PATENT EXAMINER